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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,980	08/04/2003	Richard C. Everett	03KS01	2989

7590 08/12/2005

Edward E. Roberts  
P.O. Box 3206  
Dana Point, CA 92629

EXAMINER

SCHWARTZ, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/632,980

**Applicant(s)**

EVERETT ET AL.

**Examiner**

Christopher P. Schwartz

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

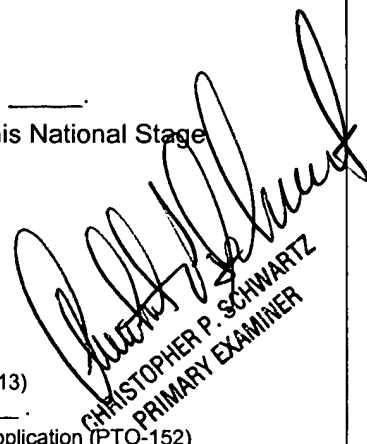
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

  
CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: applicant's have failed to identify their copending application, which has now matured into a patent.

Appropriate correction is required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-20 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,892,863 in view of Smith '747. Although applicant's prior patent shows most of the features of the present application, lacking are the particulars of the end cap.

The reference to Smith teaches it is old and well known in the art to provide such a removable closure means or end cap that is secured with pin type connection at 10.

It would have been obvious to one of ordinary skill in the art to have modified the claims of the patent to include such a removable closure means, and one that matches

the contour of the holder means -- for proper functioning of the pad, to make replacement of the pads easier.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irvine in view of Everett '959 and Smith '747 or Penney.

Regarding claims 1 Irvine shows in figure 3 a brake pad similar to applicants. Note the brake pad means 28 and the pad at 12.

Irvine lacks a showing of multiple brake pads having different braking compounds in sequential abutting relationship. Irvine also lacks closure means, in the form of an

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end cap, for complementary mating with the truncated end to secure the brake pads within the brake pad means.

It is notoriously well known in the art to make singular parts plural as a matter of obvious engineering design choice, or possibly, for easier replacement.

Everett '959 is relied upon to show it is well known to create brake pads having different compounds for desired braking and wear characteristics. See figure 5 and the abstract.

Smith is relied upon to show it is known in the art to make a brake pad or shoe from multiple parts. See elements 2. Note also the closure means at 9 and 10.

Penney is relied upon for a teaching similar to Smith. Note the closure means in the area of c and f.

One having ordinary skill in the art at the time of the invention would have found it obvious to have made the different pad sections shown in figure 3 of Irvine from multiple abutting pad sections having differing compounds, as taught collectively by Everertt and Smith or Penney, to achieve a particular set of brake and wear characteristics desired from the pad.

To make the multiple pads easier to assemble, and replace after they have worn, one having ordinary skill in the art would have found it obvious to have made a matching section, or end cap, to fit over the open end at 34 and secured as claimed, and for proper functioning of the pad, as generally suggested by the removable closure means in either Smith or Penney. Such a modification would simply amount to an

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alternate equivalent means (albeit possibly a more expensive one) of securing the pads within the means 28 as shown by Irvine at 38.

Regarding claims 2,4 as explained above and as seen in the drawings of the references applied these requirements are met.

Regarding claim 3 simply to make the pad means with a longitudinal curvature in conformance to that of the wheel rim would have been obvious to achieve optimum braking results. Note the curvatures in Smith and Penney.

Regarding claims 5,6 as broadly claimed, applicants limitations are simply an alternative equivalent "strengthening agent" to that shown by Irvine in figure 3 since Irvine provides an overlap portion on the support member 28 to prevent the brake pads from being removed. Further, glue or adhesive would be an obvious modification to the back and/or sides of the pads to make removal more difficult.

Regarding claim 7 these limitations are simply an obvious variation of what is collectively taught by the references above. Also see the discussion columns 1 and 2 of Irvine.

Regarding claims 8-18 as explained above these limitations are taught collectively by the combination of the references above.

Regarding claims 19 and 20 it would have been an obvious method to insert the multiple brake pads sequentially, as modified above, as this would easily be seen as the easiest and most expedient method of assembly.

***Response to Arguments***

7. Applicant's arguments filed 6/8/05 have been fully considered but they are not persuasive. Applicant's arguments have largely been addressed in the action above, notwithstanding the new grounds of rejection.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Conclusion***

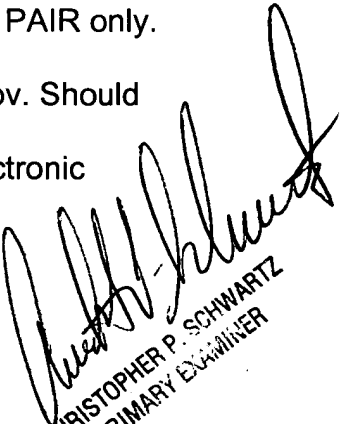
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Schwartz whose telephone number is 571-272-7123. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 571-272-7099.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cps  
8/9/05



CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER